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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/828,417	03/28/1997	HIROFUMI MIRASAKI	P9702-MG	4906

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LACKENBACH SIEGEL MARZULLO ARONSON
& GREENSPAN
ONE CHASE ROAD
SCARSDALE, NY 10583

EXAMINER

HOTALING, JOHN M

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 03/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/828,417

Applicant(s)

MIRASAKI ET AL.

Examiner

John M Hotaling II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-28,31 and 34-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-28,31 and 34-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☒ Interview Summary (PTO-413) Paper No(s) 20
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 23-28, 31, and 33-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murata et al. '743 (hereinafter Murata '743) in view of Lowe et al '401, Best '073, Best '152 and Cookson et al '950. The rejections contained in the previous office actions are relevant and incorporated and maintained. The object of the primary reference, Murata '743, is to provide a sophisticated play-by-play announcement in response to each scene or operation of the game, realistically and without hindering the game development as disclosed in column 1 lines 40-60. This is accomplished by having a storage portion operable to store data for each of a plurality of vocal sound groups, each vocal sound group is associated with a game scene. The controller designates data of a vocal sound group suitable to the produced new scene

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which make it possible to generate vocal sounds suitable for game developments, which consequently provides an improved realistic atmosphere. Murata '743 provides an example of his system using a baseball game as outlined in columns 3 and 4. In this example a baseball game contains four scenes; a batting scene, a fielding scene, a changing-over scene, and a game set scene. Each of these scenes is associated with a group of vocal sounds and these vocal sounds can be placed together in any manner that accurately provides a play-by-play commentary with respect to the play of the game. Murata '743 gives as an example for the batting scene a combination of the vocal sounds associated with that scene; "STRIKE, BATTER OUT, THREE MEN OUT". Murata '743 also give similar examples for the remainder of the example scenes. Murata '743 discloses in columns 1 and 2 a play-by-play announcement corresponding to the proceedings of the game by specifying the adequate terms from a storage portion expressing a word in connection with the game, the storage portion operable to store a plurality of vocal sound groups and a controller operable to produce a new game scene on the monitor in accordance with a game program which are the commands that take the specific sounds saved in a database and output them on a output device. In addition, each data part is assigned a specified address which is stored in the storage portion, or data base, and consists of a data region and a reference region. **Column 4 lines 25-70 discloses that the CPU designates an appropriate vocal sound group, which is a command, to be used in the play-by-play announcement in accordance with the development of the game and converts and outputs the data which can also be stored as groups of sounds. Column 5 line 17 through column 6 line 24**

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disclose the use of alternate phrases based on the play of the game such as when a strike is thrown the program switches or jumps from database to database based on the play of the game based on a predetermined procedure and database replacement condition, player action and/or command data. Murata '743 discloses on page 4 line 14 through page 5 line 12 a play-by-play announcement corresponding to the proceedings of the game by specifying the adequate terms from a glossary of terms corresponding to the proceedings of the game, and a database of the on the spot broadcasting terms with a voice output means which converts the stored data into and audible speed voice. The glossary of terms or the on-the-spot-broadcasting terms are data regions which are stored vocal sound data on databases and the storage of such being well known in the art. Murata '743 discloses in column 1 line 49 through column 2 line 5 a processing section or manipulator for monitoring the state of the game, a play-by-play announcement for a plurality of phrases or vocal sound groups, a controller to produce a new game scene and designate data for vocal sound suitable to the produced new scene. The plurality of phrase databases and plurality of phrases relative to a predetermined condition that the processing section selects from is disclosed on column 4 line 50 through column 6 line 25 where the plurality of databases are the vocal sound data storage portion. These data regions which store vocal sound data are databases. Column 4 lines 25-32 and column 7 lines 1-11 disclose the sound manipulation and output of the vocal sounds. Murata '743 discloses all of the claimed invention as but lacks in disclosing a feature that suspends commentary, provide alternate language commentary, same size databases, and wild

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cards, switching from database to database based on a predetermined event or player action replacement condition designated by a player. In an analogous machine Lowe et al. '401, column 2 lines 5-12 discloses that a game may store the video and audio material using laser disk technology, CD-ROM, computer hard drive or other storage means allowing random access retrieval. Column 3 lines 20-35 disclose that the laser video disc storage device provides for storage and retrieval of audio information.

Column 5 line 55 through column 6 line 10 discloses that the audio storage and retrieval means can utilize several different formats, and in particular the video laser disc format there may be two audio tracks for one video track and that additional audio tracks can be on other video laser discs, CD's, or on the hard drive that are run in sync with the main program. Column 7 lines 10-31 discloses the timing and control of all video and audio sequences, that the video and audio inserts database stores information on all inserts that are available to the video control logic. Column 11 lines 1-21, teaches that it is known to line up the audio and video, and to mute the play by play commentary and replace it with an audio insert which may be silence or a alternate sound such as music or a commercial. One skilled in the art would understand the teachings of Lowe et al.

'401 because of the use of speech, commentary, or an alternate sound associated with a game machine. In an analogous invention Cookson discloses on column 1 lines 5-15 that the invention relates to the generation of audio signals during play of a software carrier and more particularly to a technique by which multiple dialog languages may be recorded on separate audio tracks. Column 2 lines 25-30 disclose that the invention is not limited to a particular medium or only to the distribution of motion pictures. Column

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3 lines 25-30 disclose that it is necessary for the player to control his player for the desired language to be played. Column 12 line 30 through column 13 line 10 disclose that the special software may be game software. Column 37 claim 1 discloses a system for controlling play of the audio tracks of a digital software carrier including a dialog language and a switching master to switch to a different audio track. A predetermined event and a replacement condition designated by a player could include the player's choice in language to be used in the video game prior to the play of the video game thereby switching to an alternate language track or database. In an analogous invention Best '073 discloses the use of alternate phrase databases on figure 11 and column 11 lines 45-50 that may be stored on a disk or in memory, can be used based on the selection of a player which is player action or based on a switching command from the machine which is also a predetermined procedure. Best '152 in column 10 lines 39-70 and column 11 lines 1 and 2 disclose that the audio cue commands are of a fixed length record which are stored into a cue table and that these audio clips where a predetermined procedure for a branch point may abandon some audio cues and select others. The branch point is associated with the progression of the events in the game. The art benefits from the Best patents in that automatic or player selected switching from database to database which will result in games that will have multiple story plots and will not be predictable. The use of two announcers is well known and is an obvious matter of choice well within the capabilities of those skilled in the art since it is common place to have multiple sports announcers for commenting on a game. It would be obvious to one of ordinary skill in the art at the time of the invention to combine the

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above references the obvious motivation to combine the references is that all of the references are related to the audio placement with respect to the action occurring in the video games and all of the references teach a form of inserting the proper sounds and/or commentary based on the play of the game. Furthermore, Murata '743 discloses that the sound generator generates sounds suitable for a scene based on designated data and that a plurality of vocal sounds having the same word but different intonations and the program is able to select a proper vocal sound group according to the circumstance in the game.

Response to Arguments

2. Applicant's arguments filed 1/8/02 have been fully considered but they are not persuasive. In addition, any argument not specifically addressed in the response to arguments section can be found in the above rejection.

In response to the arguments previously submitted in the amendments mailed April 10 and December 14, 2000 which are incorporated by reference please see the response to those arguments in the corresponding rejections of 7/5/00 and 5/9/00 which are incorporated by reference. In addition, any arguments submitted December 14, 2000 and not resubmitted March 12, 2001 were not responded to.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does

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not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this instance the obvious motivation to combine the references is that all of the references are related to the audio placement with respect to the action occurring in the video games and all of the references teach a form of inserting the proper sounds and/or commentary based on the play of the game. This motivation obviates the applicants objection to improper hindsight reasoning. For additional information please see the rejection above.

With respect to the applicants argument that the examiner concedes at page 4 that Murata '743 lacks any disclosure regarding the provision of "alternate language commentary" and other features is a selective reading of the examiners position. The phrase used throughout prosecution of this application "alternate language commentary" is referring to an alternative language such as Spanish, French, etc., not an alternative phrase database for use in commentary in a game and as such renders the applicant's argument unpersuasive. With respect to "equally appropriate phrases for a specified predetermined condition" please see the rejection above. Additionally, as the examiner has pointed out many, many times, Murata discloses in column 4 lines 25-70 discloses that the CPU designates an appropriate vocal sound group, which is a command, to be used in the play-by-play announcement in accordance with the development of the game and converts and outputs the data which can also be stored as groups of sounds. Column 5 line 17 through column 6 line 24 disclose the use of alternate phrases based on the play of the game such as when a strike is thrown the

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program switches or jumps from database to database based on the play of the game based on a predetermined procedure and database replacement condition, player action and/or command data. This can be seen in figure 2 where the condition of a strike has three different interpretations such as strike, third strike, and three men out and can be determined as disclosed above.

With respect to the arguments against the Lowe reference, the examiner does not utilize this reference for the teaching of alternative phrase data but instead uses the reference to the following: that a game may store the video and audio material using laser disk technology, CD-ROM, computer hard drive or other storage means allowing random access retrieval, audio storage and retrieval means can utilize several different formats, timing and control of all video and audio sequences, that the video and audio inserts database stores information on all inserts that are available to the video control logic, and that it is known to line up the audio and video, and to mute the play by play commentary and replace it with an audio insert which may be silence or a alternate sound such as music or a commercial. The argument that the Lowe reference is clearly intended to simulate the audio environment normally encountered when watching a football game is not clear since Lowe has been cited to teach the concepts above. With respect to the remainder of the applicant's representative arguments with respect to Lowe please see the rejection and response to arguments above.

With respect to the applicants arguments that the Best patents miss the point. It is noted that the applicant's representative has missed the point that the examiner has cited the Best patents to teach that automatic or player selected switching from

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database to database which will result in games that will not be predictable which is directly relevant to the reference cited and applicable against the instant application.

Please see the rejection above.

With respect to the applicants argument that the examiner did not find a reference that teaches or suggest the invention as defined in the claims of record alleging that it would be obvious to use two announcers and to have multiple announcers commenting on a game the examiner contends that one of ordinary skill in the gaming art has a tacit understanding of creating a real simulation from what is well known in actual gaming such as multiple announcers.

With respect to the applicant's representative objection that the examiner has relied on the teachings of video games that he has played as being unreasonable and that the applicant should be allowed to respond to a written record is misleading in a multitude of ways and the examiner would like to take this opportunity to set the record straight. It is the examiners duty to rely on his knowledge of the art so as to make reasonable and pointed rejections. The phone interview in question which took place 12/01 or thereabout was an attempt to sound out the examiner by the applicant's representative for some indication by the examiner of patentable subject matter. The examiner stated that he knew of no such subject matter in the claims that would result in the allowance of the instant application and mentioned that the examiner had even played a game with multiple commentators prior to the priority date of the instant application. NO WHERE in the current record has the examiner made allegations to his knowledge of these types of games or required the applicant to respond to such. With

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respect to the applicant having the opportunity to respond to the written record the examiner contends that the all of the current rejections to the claims are contained in the written record.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to the applicants arguments that the examiner provided no motivation to combine the references please see the rejection above where the motivation is clearly pointed out.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Hotaling II whose telephone number is 703 305 0780. The examiner can normally be reached on Mon-Thurs 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (703) 308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703 746 3236 for regular communications and 703 308-7769 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-7777.



John M Hotaling II
March 5, 2002



JESSICA HARRISON
PRIMARY EXAMINER